REMARKS

The office action of has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1, 3, 6, 7, 8, 9 and 10 remain in this case, claims 2, 4 and 5 being cancelled by this response.

Claim Rejections - 35 USC § 112

1.   The examiner has rejected claims 1-10 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The examiner states that:

> The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification includes numerous goals and benefits of the invention but does not include any specific structure or detailed method steps that would allow one skilled in the art to make and/or use the invention. Particularly there is no disclosed structure, flow charts, computer programs or logic to perform the following claimed limitations. . . ."

The examiner then cites to particular portions of subparagraphs of particular claims as being ones where he alleges that there is no specific structure or detailed method steps that would allow one skilled in the art to make or use the invention, etc. These bases for rejection are overcome by the affidavit of Ondrej Frydrych which enclosed herewith and/or have been eliminated by amendment of the claims. More particularly, as to each of the particular matters specified by the examiner in claims 1, 3, 6, and 7:

a.   As to "identifying at least one property housing large of separate departments with appropriate populations and infrastructure that justify the setting-up of a connected strategic outsourcing venue" [as set forth in claim 1(a)], the claim has been amended by deleting this subparagraph and adding part of its subject matter to the preamble.

b.   As to "convincing the entity to provide the venue for the service center" [as set forth in claim 1(c)], this subparagraph has been deleted from the claim. It is unnecessary to the

subject matter and is, generally speaking, subsumed under subparagraph (b), which has not been rejected by the examiner under 112.

        c.   As to "providing cost-management to the users of the multiple services in a portfolio-style management" [as set forth in claim 1(g)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author of the claim means a tool for use with a web-based processing system which would provide the users with an overview of the services they procure and the pricing for those services and also a mechanism to control the spending limits for each of the services. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

        d.   As to "providing online billing, payment and transaction processing capability for multiple users, multiple services and multiple individual service providers, simultaneously" [as set forth in claim 1(h)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author of the claim means a system for use with a web-based processing system which acts as a gateway between service providers and customers. That is a system which consolidates service requests from users and presents them to service providers. The processing of, billing and payment for these services is administered using the system. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

        e.   As to "providing order-entry confirmation and giving automated status feedback at predetermined intervals" [as set forth in claim 3(b)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system which will automatically confirm an order to the user

(email, page, etc) and will keep the user updated about the status of the service request. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

f.   As to "providing customized catalogs and personalized pricing" [as set forth in claim 3(c)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system, which will allow for customized catalogs, i.e. catalogs, whose content is suited to the needs of each individual customer. The system should also allow for customized price lists, where each customer has its own exclusive price list, which is then applied for all purchases of that customer. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

g.   As to "providing usage tracking and trending" [as set forth in claim 3(d)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the system for use with a web-based processing system should collect and present information on service usage, both in service volume terms (number of requests, etc) as well as monetary volumes. The information should also be viewable in the form of charts which would allow for trend analysis. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

h.   As to "providing online billing" [as set forth in claim 3(e)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system which can calculate the total price based on the sum of individual item prices. The total price is then presented to the user in a form that also

allows for online payment. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

i.   As to "routing orders automatically" [as set forth in claim 3(f)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system which allows for the definition of a workflow, which routes the orders automatically to the appropriate services center, based on pre-determined business logic. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

j.   As to "tracking flow-through items with details of recency, frequency, usage and monetary value" [as set forth in claim 3(g)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system which allow for delivery of flow through items while tracking the above mentioned information about each transaction. For example should the user order a ream of paper, the order and delivery of the paper would be recorded in the system, which would then allow for an analysis of the sales of reams of paper in terms of recency, frequency, usage and monetary value. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

k.   As to "capturing preferences of users" [as set forth in claim 3(i)] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system which will allow the user to set his/her preferences in terms of services that the user procures (for example setting the default to express deliver and payment with credit card whose information is on file) but also the preference for working with the system (ie. Form of address, color scheme, etc). He states that

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provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

1.   As to "a system that automatically accepts schedules and routes service requests to the appropriate fulfillment center based on desired service level, type of service, capacity utilization, load factors at various centers and other factors and immediately confirms receipt and confirms completion of the service request and convincing the entity to provide a venue includes negotiating terms that allow a flexible engagement within the at least one property" [as set forth in claims 6 and 7] the affidavit of Ondrej Frydrych establishes that it would have been clear based on the specification to one of ordinary skill in the art to which the claims pertain, or to which they are most nearly connected, in 1999 and 2000 how to implement this/these function(s) because it is obvious that the author means a system for use with a web-based processing system combining the features presented in the previous paragraphs. That is a system which ensures automatic workflow of service requests based on pre-determined business logic. A system that also provides confirmation of requests to the user and regular status updates communicated to the user. He states that provision of a software system or application for this/these purpose(s) is well within the ordinary skill in the art in view of the description given.

2.   The examiner has also rejected claims 6 and 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this regard, the examiner states that these "claims are directed to a system but no components of the system are included to perform the claimed functions."

This complaint has been dealt with by provision of a suitable preamble identical to that provided in claims 1 and 3, where this issue has not been raised. The steps of the claims now clearly relate to a "web-based processing system wherein a tenant occupant / end user is interconnected from a property via a computer network to a system that performs a method including the steps of . . ." In addition, applicant has split steps into paragraphs for greater clarity at the beginning of claims 6 and 7.

Applicant further notes that the efficacy of the instructions given with respect to certain disputed parts/steps of claims 6 and 7 has already been confirmed by Ondrej Frydrych in his

accompanying affidavit. In addition, applicant contends that these claims clearly point out the subject matter of the invention and the functions of the software/systems utilizing the invention. Claims 6 and 7 relate to a web-enabled service delivery and load balancing system that automatically accepts, schedules and routes service requests to the appropriate fulfillment center and allows individual desktop and other users to select print or some other function to compress files, encrypt them, send service request information as meta-information and have automatic status notification via a dialogue box. The elements recited are very specific and clearly point out the method and processing system of the invention with computers, data, and meta information, where such service requests are sent to implementation kiosks or venues that are the pre-fabricated setup of high-end printing equipment and computers networked to each other and connected to the internet according to the method and processing system of the invention.

Claim Rejections - 35 USC § 101

The examiner has rejected claim 2 under 35 U.S.C. 101, stating that "the claimed invention is directed to non-statutory subject matter." The examiner continues, stating:

> The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

> For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use or advance the technological arts.

> In the present case, claim 2 recites only an abstract idea. The recited steps of merely identifying an arbitrage opportunity, pooling service requirements, off loading pooled service requirements and generating a perpetual arbitrage opportunity do not apply,

involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to identify a market niche.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result.

In the present case, claim 2 generates arbitrage opportunities (i.e. useful) is repeatable (i.e. concrete) and produces a real or actual effect (i.e. tangible).

Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 2 is deemed to be directed to non-statutory subject matter.

However, Claim 2 is not an abstract idea. It falls within the technological arts and has clearly been applied by developing a web-based software that is specifically utilizing the business method and processing system of the invention:

a) The Description of the Invention references a web-enabled print on demand and variable data printing, image and text distribution, and repositories; digital, local and domestic courier services service delivery and load balancing system that automatically accepts, schedules and routes service requests to the appropriate fulfillment center – *this is sufficiently specific for the art* in question which is how the implementation can be done.

b) Claim 7 refers to a service delivery and dynamic load balancing system of claim 6 used in synchronization with the processing system of claim 3 which allows individual desktop and other users to select the print or some other function – *this is precisely what was implemented in reality and can be seen from screen-shots of the system developed, which clearly demonstrates that the idea does fall within the technological arts and produces a useful, concrete and tangible result.*

Nonetheless, in order to speed the processing of this matter with regard to claims of more immediate value to the applicant, claim 2, and two additional claims incorporating the limitations

of claim 2 (claims 4 and 5), have been cancelled. This cancellation is made without prejudice to any rights applicant may have to pursue these claims in successor applications.

Summary

Claim 1: Applicant has amended claim 1 so as to eliminate certain subparagraphs rejected under the first paragraph of 112 and has provided an affidavit to show that the remaining subparagraphs are enabled under the first paragraph of 112.

Claims 2, 4 and 5: Have been cancelled.

Claim 3: Applicant has provided an affidavit to show that the rejected subparagraphs and parts of this claim are enabled under the first paragraph of 112.

Claims 6 and 7: Applicant has amended these claims to overcome the rejection under the second paragraph of 112. In addition, applicant has provided an affidavit to show that the rejected subparagraphs and parts of these claims are enabled under the first paragraph of 112.

Claims 8, 9 and 10: These claims have not been rejected on any independent basis, but are dependent on claim 1. Claim 9 has been amended to change its dependency on a clause of claim 1 that was eliminate, but is otherwise unchanged. Applicant has also provided an affidavit to show that the rejected subparagraphs and parts of these claims are enabled under the first paragraph of 112. Thus, claims 8, 9, and 10 should now be considered allowable.

Conclusion

Applicant believes, based on the foregoing, that the Examiner's rejections have been fully addressed, and the claims are now in condition for allowance. Reconsideration and withdrawal of the rejection are respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:
Sanders

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